

## REMARKS

Reconsideration of this application, as amended, is respectfully requested.

### **I     Status of the Claims**

Claims 51-56 are canceled without prejudice.

Claims 57-68 have been added.

Claims 1 and 12 have been amended.

Claims 1-13 and 57-68 are pending.

Amendments to claims 1 and 12 and new claims 57-68 add no new matter. See the specification, page 10, lines 5-8 and page 9, lines 14-30.

### **II    Telephone Interview**

The Applicants would like to thank Examiner Walczak for all of the courtesies extended in the telephone interview held on October 2, 2002 to Louis DelJuidice. The Applicants would like to thank the Examiner for discussing new claim limitations and further prosecution based on the Examiner's helpful suggestions, and to permit full consideration of the patentability of the unique compositions of the claimed stick products. Applicants are submitting this Amendment with a Request for Continued Examination (RCE).

### **III   Rejections Under 35 U.S.C. § 112**

Claims 51 and 53 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Applicants respectfully traverse the above rejection by stating that claims 51-56 have been cancelled without prejudice. Thus, Applicants respectfully request that the above rejection be withdrawn.

#### **IV     Rejections Under 35 U.S.C. § 103(a)**

Claims 1-13 and 51-56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 1,499,784 to Recker in view of U.S. Patent No. 3,129,930 to Prince. The Examiner states in regard to claims 1, 3, 4, 5 and 12, that Recker discloses a lipstick product comprised of a container 10, 11, having smooth interior and exterior contour, wherein the composition 17 is in sliding contact with the walls and is advanceable and retractable in the container and wherein the wall proximate to the composition are rigid throughout and a screw 15 rotatably connected to the container and disposed within the composition in order to advance/retract the composition when turned. However, the Examiner admits that Recker does not disclose the stick being formed from two different compositions. The Examiner states that Prince discloses another lipstick product wherein the product is formed from a first composition 14 and a second composition 11, which differ in color to form a predetermined multi-color image in order to enable a user to easily apply two different colors of lipstick. Thus, the Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to include two-composition lip-stick into the Recker's container in order to enable a user to easily apply a lipstick having two different colors based on the teachings of Prince.

The Applicants respectfully request withdrawal of this rejection in view of the amendments to the claims. Claims 1, 12 and 57 have been amended to recite the limitation that the molded stick composition "appears transparent or translucent when applied to a substrate". The specification, on page 10, lines 5-8, specifically states that the compositions contain colorants but become transparent or translucent when applied. Thus, the presently claimed invention does not leave an opaque residue or color the substrate it is applied to. This characteristic distinguishes the claims from the references that disclose lipstick products that impart opaque color to the lips. See Recker, column 1, lines 37-41; column 2, lines 82-89 and Prince column 1, lines 31-64; and column 2, lines 40-43. Neither reference discloses or suggests products as precisely claimed, and, indeed lipsticks, which impart opaque color, lead away from products that are transparent or translucent when applied. The Applicants respectfully traverse the rejections of claims 2-11, 13, 58-66 and 68 by stating that these claims define over the prior art based on their dependency on the independent claims and their own recitation. The Applicants respectfully request that this rejection be withdrawn.

Additionally, claim 67 recites the limitation that the first and second compositions have a first and second color and the second color provides good contrast with the first color. This limitation is not taught or disclosed in Prince. Prince clearly states that the object of his invention is to create natural coloration and a gradation of color to the lips (Prince, column 1, lines 10-19). The specification of the present invention gives examples of contrasting color combinations, e.g. red and green, yellow and purple and orange and brown (*see*, page 9, lines 14-30). These color schemes are opposite to the stated object of Prince's

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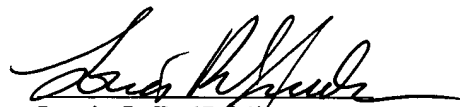
invention. Thus, Prince teaches away from using two contrasting colors. The Applicant respectfully states that Prince fails to teach or suggest the invention of claim 67.

### CONCLUSION

In view of the foregoing, it is believed that claims 1-13 and 57-68 are in condition for allowance and is respectfully requested that the application be reconsidered and that all pending claims be allowed and that the case is passed to issue.

If there are any other issues remaining to be examined or believed to be resolved to either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Respectfully submitted,



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MAIL CERTIFICATE

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PATENT TRADEMARK OFFICE

Docket No: 0630/0G528

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: J. LOOK, et al.

Serial No. 09/584,640

Art Unit: 3751

Confirmation No.: 4278

Filed: May 31, 2000

Examiner: D. Walczak

For: **MULTI-COMPOSITION STICK PRODUCT AND A PROCESS AND SYSTEM FOR MANUFACTURING THE SAME**

RECEIVED  
OCT 24 2002  
TECHNOLOGY CENTER R3700

**MARK-UP FOR AMENDMENT OF OCTOBER 15, 2002**

**PURSUANT TO 37 C.F.R. §1.121**

October 18, 2002

Assistant Commissioner for Patents  
Washington, DC 20231

**IN THE CLAIMS:**

Please replace claims 1 and 12 with the following amended claims 1 and 12.

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1. (Fourth Amended) A multi-composition stick product, comprising:

(a) a container having walls, an exterior contour, and an interior contour, said interior contour being substantially smooth; and

(b) a molded stick composition disposed so as to be in sliding contact with the walls of the container and be advanceable and retractable in the container, wherein all of the walls of the container proximate to said molded stick composition are rigid throughout, the stick composition comprising:

(i) a first composition; and

(ii) a second composition;

wherein the first and second compositions differ by at least one component and the compositions are arranged in a predetermined non-random pattern that is reproducible, and wherein the stick composition appears transparent or translucent when applied to a substrate.

12. (Fourth Amended) A multi-color stick product, comprising:

(a) a container having walls, said walls being substantially smooth; and

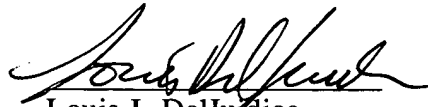
(b) a molded multi-color stick composition disposed so as to be in sliding contact with the walls of the container and be advanceable and retractable in the container, wherein all of the walls of the container proximate to said molded stick composition are rigid throughout, the stick composition comprising:

(i) a first composition; and

(ii) a second composition;

wherein the first and second compositions differ in color and are arranged in a predetermined non-random image that is reproducible, and wherein the stick composition appears transparent or translucent when applied to a substrate.

Respectfully submitted,



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